

REMARKS/ARGUMENTS

Upon entry of this amendment, claims 8 and 9 will be canceled without prejudice or disclaimer of the subject matter recited therein, and claims 1, 10 and 26-28 will be amended, whereby claims 1-7 and 10-28 will remain pending. Claims 1 and 26-28 are independent claims.

The amendments to the claims are supported by Applicants' originally filed disclosure, including originally filed claim 9. Moreover, the claims have been amended to modify claim dependency based upon the amendment to independent claim 1.

Reconsideration and allowance of the application are respectfully requested.

Consideration Of Information Disclosure Statements

Applicants express appreciation for the inclusion with the Office Action of initialed copies of the Forms PTO-1449, whereby the Examiner's consideration of the Information Disclosure Statements filed with the application and by certificate of mailing on November 5, 2004 and August 1, 2005 is of record.

Claim of Foreign Priority

Applicants express appreciation for the acknowledgement of the claim of priority and receipt of the certified copy of the German priority application.

Rejections

(a) Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/788,607; over claims 1-41 of copending Application No. 10/789,881; over claims 1-24 of copending Application No. 10/789,751; over claims 1-30 of copending Application No. 10/789,750; over claims 1-24 of copending Application No. 10/789,641 and over claims 1-10 of copending Application No. 10/500,869.

In response, Applicants submit that in order to support an obviousness-type double patenting rejection, the rejection must be based upon similar criteria to that of an obviousness rejection. For example, in order to constitute a proper basis of rejection, the differences between the claimed subject matter must be compared to the subject matter claimed in the referenced application upon which unpatentability is asserted. In the instant situation, the rejection merely contends that, "Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and all of the above stated copending applications are claiming a cosmetic or dermatological formulation comprising at least one UV filter substance and at least one dialkyl naphthalate of the exact same structural formula."

There is no indication of differences between the claimed subject matter and why one having ordinary skill in the art would have been motivated to modify the subject matter claimed in any of the copending applications to arrive at Applicants' claimed subject matter.

Accordingly, the obviousness-type double patenting rejection is without appropriate basis and should be withdrawn.

(b) Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/789,711 in view of USP 6,660,402 B1 to Gonzales et al. (hereinafter “Gonzales”)

In this ground of rejection, it is asserted that the copending application differs from the instant claims because of the presence of one insect repellent compound, more specifically DEET. The rejection contends that Gonzalez discloses photostable sunscreen compositions comprising a sunscreen active and a cosmetically acceptable vehicle, and that in column 4, lines 50-65, Gonzalez further discloses that one or more insect repellents may also be present such as DEET. The rejection concludes that it would have been obvious to one of ordinary skill in this art at the time the invention was made to have included the DEET of Gonzalez into the instant composition in view of the teaching of Gonzalez that insect repellents are present in suncreening compositions. The rejection also contends that the rejection is based upon absence of any clear showing of unexpected results attributable to the presence of DEET in the referenced claims.

In response, Applicants submit, for the reasons previously noted above, the rejection is without appropriate basis as not stating required showings for an obviousness rejection. The rejection must at least establish why it would have been obvious to modify the referenced claims to arrive at Applicants' claimed subject matter.

In the instant situation, the rejection is silent with respect to any motivation for omitting DEET from the referenced claims.

Accordingly, the rejection is without appropriate basis and should be withdrawn.

(c) Claims 1-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,368,578 B1; over claims 1-9 of U.S. Patent No. 6,355,230 B2 and over claims 1-4 of U.S. Patent No. 6,491,901 B2.

The rejection contends that although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and all three of the patents are claiming a cosmetic or dermatological formulation comprising at least one UV filter substance and at least one dialkyl naphthalate of the exact same structural formula. The rejection contends that no patentable distinction can be found between the instant claims and the above stated referenced patents.

In response, Applicants again submit that in order to support an obviousness-type double patenting rejection, the rejection must establish similar criteria to an obviousness rejection. In the instant situation, there is no indication of differences between the claimed subject matter and why one having ordinary skill in the art would have been motivated to modify the claimed subject matter of any of the patents to arrive at Applicants' claimed subject matter.

Accordingly, the rejection is without appropriate basis and should be withdrawn.

(d) Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by all Gers-Barlag et al. patents USP 6,368,578 B1(R1), USP 6,355,230 B2(R2) and USP 6,491,901 B2(R3).

In response, Applicants respectfully submit that none of the patents discloses the at least one particulate UV filter substance is a micronized inorganic pigment, as recited in Applicants' claims. Accordingly, for at least this reason, this ground of rejection is without appropriate basis and should be withdrawn.

Moreover, in order that the record is complete, Applicants note that in accordance with 35 U.S.C. (c)(1) subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 does not preclude patentability based upon obviousness where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. Thus, in order that the record is complete, Applicants note that the invention was owned by, or subject to an obligation of assignment to, the same entity as the reference at the time this invention was made.

Accordingly, withdrawal of the rejection is respectfully requested.

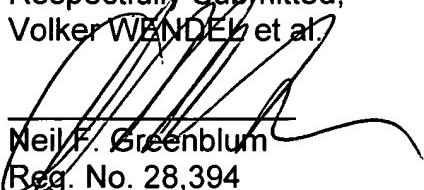
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should the Examiner have any questions regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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